



UNITED STATES PATENT AND TRADEMARK OFFICE

4L

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------|-------------|----------------------|---------------------|------------------|
| 10/617,303 | 07/10/2003 | Soo S. Ko | PH -7193 | 2929 |
| 24348 | 7590 | 09/09/2004 | EXAMINER | |
| BRISTOL-MYERS SQUIBB COMPANY | | | CHANG, CELIA C | |
| PATENT DEPARTMENT | | | ART UNIT | |
| P.O. BOX 4000 | | | PAPER NUMBER | |
| PRINCETON, NJ 08543-4000 | | | 1625 | |

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,303

Applicant(s)

KO ET AL.

Examiner

Celia Chang

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

DETAILED ACTION

1. A preliminary amendment was filed on Aug. 7, 2003. Claims 1-21 have been canceled. Claims 22-40 are pending.

2. Claims 22-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *allowed* claims 1-3, 5, 7, 9, 11-13, 15, 17, 19, 21, 25-28, 32-35, 37-39, 41-42 of copending Application No. 10/180,869 in view of US 6,323,223.

Claims 22-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7, 9, 10, 13-21 of copending Application No. 10/635,946 in view of US 6,323,223.

This is a provisional obviousness-type double patenting rejection.

Determination of the scope and content of the prior art (MPEP §2141.01)

The allowed claims of SN 10/180,869 and the copending claims of SN 10/635,946 are drawn to sets of compounds for G is bond ('869) or carbonyl/sulfonyl ('946), wherein the B moiety of the instant claims is carbocyclic.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the allowed/copending claims and the instant claims is that instead of carbocyclic, the B moiety is heterocyclic. Gong et al. US 6,323,223 is analogous art disclosing cyclic amine urea compounds having CCR3 activity wherein the linker ring (CR³R⁴ see col. 2 lines 50-51 and examples 2 and 47) being carbocyclic or heterocyclic are optional choices for such compounds.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art is deemed to be aware of all the pertinent art in the field. The above claims placed the B ring being optionally carbocyclic or heterocyclic in the possession of artisan in the field. The modification of a known compound with attributes of another proven compound is prima facie obvious. There is no good reason that why applicants should be granted improper timewise extension of the "right to exclude" on known obvious variations for inventions already or to be patented by applicants.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 1625

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 22-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Broadly, the claims read on the compound of CA 135:137529 wherein the R5 moiety is heterocyclic thus, read on the claims yet the Ikegami et al. compounds are VLA-4 active. The specification lacks sufficient variations of operable examples of R5 being heterocyclic which would provide guidelines as to how to pick and choose compounds having the claimed utility while state of the art indicated compounds reading on the claims have patentably independent and distinct utility (see CA 135). Therefore, in view of the high degree of unpredictability in chemokine receptor activity and the totally unrelated activity in similar compounds as indicated by analogous compounds by Ikegami, the descriptive and enabling support for the "scope" as claimed is lacking.

In addition, claims 31, 34-36, 39-40 are considered reach-through claims without sufficient enabling support for the claimed scope in modulating chemokine receptor activity or CCR3 receptor activity or treating inflammatory diseases. While screening and assay indicated that compounds encompassed by the claims have efficacy in inhibiting one or more functions of mammalian chemokine receptor thus can inhibit inflammation which is a symptom occurring in many diseases, does not necessarily have efficacy in treating the "cause" of the disease i.e. the disease per se. (see Cecil medical textbook p.1937-1938).

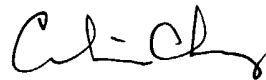
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Sept. 3, 2004

A handwritten signature in black ink, appearing to read 'Celia Chang', with a stylized flourish at the end.

Celia Chang
Primary Examiner
Art Unit 1625